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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/026,023	12/21/2001	Helmut Haning	Le A 34 980	8639

7590 01/30/2003
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EXAMINER

STOCKTON, LAURA

ART UNIT PAPER NUMBER

1626

DATE MAILED: 01/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.



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10

DATE MAILED:

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

☒ Responsive to communication(s) filed on November 20, 2002

☐ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), ~~which~~ whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-20 are pending in the application.

Of the above, claim(s) 14-19 are withdrawn from consideration.

☐ Claim(s) is/are allowed.

☒ Claim(s) 1-13 and 20 are rejected.

☐ Claim(s) is/are objected to.

☐ Claim(s) are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☒ received.

☐ received in Application No. (Series Code/Serial Number)

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received:

☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of Reference Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s) 4

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

-SEE OFFICE ACTION ON THE FOLLOWING PAGES-

10/026,023

DETAILED ACTION

Claims 1-20 are pending in the application.

Election/Restrictions

Applicant's election of Group I, claims 1-13 and 20, and the species of Example 6 on page 66 in Paper Nos. 7 and 9 is acknowledged.

Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

The requirement is still deemed proper and is therefore made FINAL.

Claims 14-19 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to nonelected inventions. Election was made **without** traverse in Paper Nos. 7 and 9. Claim 17 should not have been grouped in Group I since claim 17 depends from claims 14-16.

It is suggested that in order to advance prosecution, the non-elected subject matter be cancelled when responding to this Office Action.

Priority

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Claim Objections

Claims 7-9 and 11-13 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot depend from any other multiple dependent claim. See MPEP § 608.01(n).

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 4-13 and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims must, under modern claim practice, stand alone to define an invention, and incorporation into claims by express reference to the specification is not permitted. Ex parte Fressola, 27 USPQ 2d 1608 (1993). Therefore, claims 4 and 5 are indefinite because formula 1 is not present in these independent claims.

In claims 7 and 20, the phrases “the radical $-C(O)-R^{10}$ has the indicated meanings of R^{10} ” and “the radical $-C(O)-R^{10}$ has the indicated meanings of R^{10} indicated above for a group”, respectively, are confusing as to its meaning.

Claim 10 does not conform to M.P.E.P. 608.01(m) since each claim must end with a period and no other periods may be used elsewhere in the claims except for abbreviations {see the end of the definition of R^6 }.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Haning et al. {WO 01/70687}.

Determination of the scope and content of the prior art (MPEP §2141.01)

Applicants claim indole compounds. Haning et al. teach indole compounds which are structurally similar to the instant claimed compounds. See in Haning et al., for example, the compounds of Formula (I) wherein Z is oxygen, R¹ and R² are each trifluoromethyl {e.g., CF₃} and are ortho to the bridge bond, R³ is -NH-CH₂-C(=O)-OH {e.g., A is NR⁹, R⁹ is hydrogen, n is 1, m is 1, R⁸ is hydroxy}, R⁴, R⁵, R⁶ and R⁷ are each hydrogen (pages 2-5, 39 and 44; and Examples 1 and 2 on page 107). Haning et al. teach that their indole compounds are useful for treating diseases that can be treated using thyroid hormones.

Ascertainment of the difference between the prior art and the claims (MPEP §2141.02)

The difference between the compounds of the prior art and the compounds instantly claimed is that of generic description.

Finding of prima facie obviousness--rational and motivation (MPEP §2142-2413)

The indiscriminate selection of “some” among “many” is *prima facie* obvious, *In re Lemin*, 141 USPQ 814 (1964). The motivation to make the claimed compounds derives from the expectation that structurally similar compounds would possess similar activity (e.g., treating obesity).

One skilled in the art would thus be motivated to prepare compounds embraced by the prior art to arrive at the instant claimed compounds with the expectation of obtaining additional beneficial compounds which would be useful in treating, for example, obesity. Therefore, the instant claimed invention would have been suggested to one skilled in the art.

Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

Allowable Subject Matter

The elected species of Example 6 is allowable over the art of record since the closest prior art of record {WO 01/70687} fails to teach or suggest the group, $\text{-NH-C(O)-CH}_2\text{-C(O)O-}$, which is defined by the instant R^3 variable.

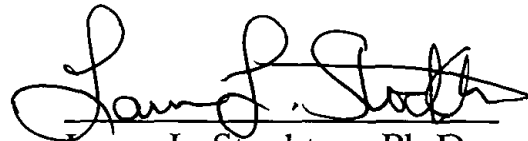
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laura L. Stockton whose telephone number is (703) 308-1875. The examiner can normally be reached on Monday-Friday from 6:00 am to 2:30 pm. If the examiner is out of the Office, the examiner's supervisor, Joseph McKane, can be reached on (703) 308-4537.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1235.

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The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556.

A handwritten signature in black ink, appearing to read "Laura L. Stockton", written over a horizontal line.

Laura L. Stockton, Ph.D.

Patent Examiner

Art Unit 1626, Group 1620

Technology Center 1600

January 29, 2003